

REMARKS

Applicants respectfully request reconsideration and reexamination of the present application in light of the amendments and the remarks below.

Claims 1-7 and 9-12 are pending in this application. Claims 1 and 12 have been amended. These claim amendments are made to clarify the subject matter therein. Therefore, these amendments are submitted in order to place the claims in condition for allowance, and do not disclaim any subject matter to which the Applicants are entitled.

The Examiner has elected to restrict claims 6 and 7, and has withdrawn these claims from consideration (Paper No. 9, page 2).

Rejection Under 35 U.S.C. § 112, first paragraph

The Examiner rejected claim 12 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention (Paper No. 9, pages 5-7).

The Examiner stated that claim 12 is directed to “organic diseases,” and the specification does not reasonably provide enablement for the instantly claimed compounds.

Claim 12 has been amended to clarify the claimed subject matter.

It is thus submitted that the claim 12 meets the requirements of 35 USC § 112, first paragraph, and reconsideration and withdrawal of the present rejection is respectfully requested.

Rejection Under 35 U.S.C. § 102

The Examiner maintained the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated by STN International CAPLUS Database, Accession No. 1991:514130; Fujisawa Pharmaceutical Co., Ltd, Japanese Patent JP03056431 (1991), abstract (“JP03056431”) (Paper No. 9, pages 2-3 and 7-8). Applicants respectfully traverse.

In order to support anticipation under 35 U.S.C. §102, each and every element of a claimed invention must be disclosed within a single prior art reference. *See In re Bond*, 15 USPQ2d 1896 (Fed. Cir. 1991).

Claim 1 of the present invention has been amended such that A is oxygen. Thus, the present invention relates to sulphonic esters, and methods of treating pain and neurodegenerative disease by administration of the compounds of the present invention.

The compounds disclosed in JP03056431 are biphenyl compounds, however, JP03056431 does not teach or disclose sulphonic esters.

Therefore, since JP03056431 does not teach or disclose sulfonic esters, JP03056431 does not teach each and every limitation of the claimed invention, and a proper rejection under 35 U.S.C. § 102(b) has not been established. Accordingly, Applicants respectfully request reconsideration and withdrawal of the of the present rejection.

Rejection Under 35 U.S.C. § 103(a)

The Examiner maintained the rejection of claim 1-5 under U.S.C. § 103(a) as unpatentable over STN International CAPLUS Database, Accession No. 1991:514130; Fujisawa Pharmaceutical Co., Ltd, Japanese Patent JP03056431 (1991), abstract (“JP03056431”) (Paper No. 9, pages 3-5 and 8-9). Applicants respectfully traverse.

Claim 1 of the present invention has been amended such that A is oxygen. Thus, the present invention relates to sulphonic esters, and methods of treating pain and neurodegenerative disease by administration of the compounds of the present invention.

As discussed above, JP03056431 does not teach or suggest sulphonic esters nor does it teach or suggest how to make sulphonic esters. Furthermore, based on the disclosure of JP03056431, one skilled in the art would not have been motivated to prepare the sulphonic esters of the present invention with the requisite reasonable expectation of success. That is, sulphonic esters are distinct chemical structures and possess distinct chemical properties, factors which may alter biological activity. Thus, based on the disclosure of JP03056431, one skilled in the art would not be motivated to prepare sulphonic esters compounds with the expectation of producing compounds that may be used for the treatment of pain and neurodegenerative diseases.

It is therefore respectfully submitted that JP03056431 fail to teach or suggest the compounds as presently claimed, and that the current invention is novel and nonobvious in view of the prior art references. For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the present rejection.

Claim Objections

The Examiner objected to claims 2 and 9-11 as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims (Paper No. 9, page 7).

Claims 2 and 9-11 depend from claim 1, and claim 1 has been amended.

Thus, it is respectfully submitted that claim 1 is in condition for allowance, and therefore, dependent claims 2 and 9-11 would also be allowable.

CONCLUSION

For the foregoing reasons, Applicants submit that the claims are in condition for allowance and Applicants respectfully request reexamination of the present application, reconsideration and withdrawal of the present rejections and objections, and entry of the amendments. Should there be any further matter requiring consideration, Examiner Wright is invited to contact the undersigned counsel.

If there are any further fees due in connection with the filing of the present reply, please charge the fees to undersigned's Deposit Account No. 13-3372. If a fee is required for an extension of time not accounted for, such an extension is requested and the fee should also be charged to undersigned's deposit account.

Respectfully submitted,

July 31, 2003

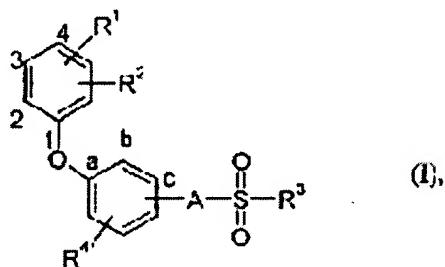


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Amended Claims (Attorney Docket No. LeA 34 813)

1. (Currently amended) Compounds of the general formula (I),



in which

R^1 denotes hydrogen, C_1-C_4 -alkyl, halogen, trifluoromethyl, trifluoromethoxy, cyano or nitro,

R^2 denotes halogen, trifluoromethyl, trifluoromethoxy, cyano or nitro,

R^3 denotes C_4-C_7 -alkyl which may be substituted one or more times by fluorine or chlorine,

R^4 denotes hydrogen or halogen, and

A denotes oxygen or NH .

2. (Original) Compounds according to Claim 1,

where

R^1 denotes hydrogen, fluorine, chlorine, methyl, trifluoromethyl, trifluoromethoxy, cyano or nitro,

R^2 denotes fluorine, trifluoromethyl, trifluoromethoxy, cyano or nitro,

R^3 denotes n-butyl, n-pentyl, 4,4,4-trifluorobut-1-yl or 5,5,5-trifluoropent-1-yl,

R^4 denotes hydrogen, and

A denotes oxygen.

3. (Original) Compounds according to claim 1 or 2,

where

R^1, R^2, R^3, R^4 and A have the meaning stated in claim 1 or 2, and

there is a hydrogen atom in position 4 of the phenyl ring substituted by R^1 and R^2 .

4. (Original) Compounds according to claim 1 or 2,

where R^1, R^2, R^3, R^4 and A have the meaning stated in claim 1 or 2, and

R^1 and R^2 occupy positions 2 and 3 on the phenyl ring.

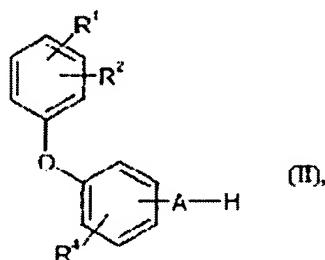
5. (Previously presented) Compounds according to Claim 1

where

R^1, R^2, R^3, R^4 and A have the meaning stated in Claim 1, and

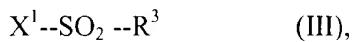
A is in position c of the benzene radical.

6. (Original) Process for preparing compounds according to Claim 1, characterized in that a compound of the general formula (II)



in which R^1, R^2, R^4 and A have the meaning stated in Claim 1,

is reacted in an inert solvent in the presence of a suitable base and, where appropriate, in the presence of a phase-transfer catalyst with a compound of the general formula (III)

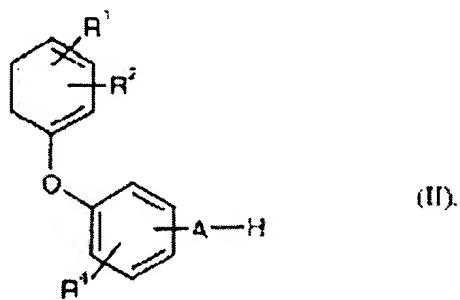


in which

X^1 represents a suitable leaving group, and

R^3 has the abovementioned meaning.

7. (Previously presented) Compounds of the general formula (II),



in which R^1 , R^2 , R^4 and A have the meaning stated in Claim 1.

8. Cancelled.

9. (Previously presented) A pharmaceutical composition containing at least one of the compounds according to Claim 1 mixed with at least one pharmaceutically suitable essentially nontoxic carrier or excipient.

10. (Previously presented) A method of treating states of pain, comprising administering to a mammal an effective amount of a compound according to claim 1, wherein said pain is acute pain, chronic pain, cancer-induced pain, chronic neuropathic pain, diabetic neuropathy, neuralgia, peripheral nerve damage, central pain, trigeminal neuralgia, lumbago, back pain, or rheumatic pain.

11. (Previously presented) A method of treating Parkinson's disease, comprising administering to a mammal an effective amount of a compound according to claim 1.
12. (Currently amended) A method of treating states of neurodegenerative disorders, comprising administering to a mammal an effective amount of a compound according to claim 1, wherein said neurodegenerative disorder is cerebral vasospasm, cerebral ischaemias, craniocerebral trauma, migraine, spasticity, anoxia, hypoxia, perinatal asphyxia, autoimmune diseases, metabolic diseases, ~~organic diseases~~, epilepsy, brain disorders associated with atherosclerotic disease or arteriosclerotic disease, depression, Alzheimer's disease, Parkinson's disease, Huntington's disease, multiple sclerosis, amyotrophic lateral sclerosis, multi-infarct dementia, or neurodegenerative disorders associated with bacterial and viral infections.